

REMARKS

Claim Rejections:

In the office action dated February 21, 2003, the examiner rejected claims 9-10 under 35 U.S.C. §112, ¶ 2 on the grounds that a proper composition claim must recite a carrier. Since claim 9 recites a carrier, applicants assume the examiner meant claim 8 instead of claim 9. Accordingly, applicants amend claim 8 to recite "mixture" instead of "composition." Applicants also amend claim 10 to refer to the composition as claimed in claim 9.

The examiner has also noted that claim 2 would be allowable if rewritten in independent form. Accordingly, the applicants amend claim 2 to read as an independent claim.

The examiner has also rejected claims 1 and 3-10 on the grounds that they are not enabled by the disclosure under 35 U.S.C. § 112, ¶ 1. The initial burden is on the examiner to show that the specification fails to teach a person of ordinary skill in the art how to make and use the claimed invention *without undue experimentation*. See MPEP § 2164.04.

The examiner has not sustained his burden to establish why the skilled worker, with the applicants' disclosure before him/her, would have been unable to practice the *invention as a whole* -- including those embodiments wherein R¹ is a haloalkyl --without undue experimentation. Cf. MPEP § 2164.04. Some experimentation, even if complex, is permitted. See *M.I.T. v. A.B. Fortia*, 774 F.2d 1104, 227 U.S.P.Q. 428 (Fed. Cir.

1985).

Furthermore, inclusion of a single inoperative embodiment among many operative embodiments (assuming the examiner to be correct) does not, in and of itself, establish lack of compliance with the enablement requirement of 35 U.S.C. § 112, ¶ 1. See, *inter alia*, *In re Angstadt*, 190 U.S.P.Q. 214, 219 (CCPA 1976) (“[N]obody will use them [the inoperative embodiments] and the claims do not cover them”) and *In re Dinh-Nguyen*, 181 U.S.P.Q. 46, 48 (CCPA 1974) (“It is not a function of the *claims* to specifically exclude . . . possibly inoperative substances . . .”).

Objections to the Specification:

Applicants respectfully point out that the Patent Office acknowledged receipt of the abstract for this application on June 12, 2001 (see enclosed photocopy of postcard). Applicants also enclose an extra copy of the abstract.

Applicants have also amended Table 2 to correct the orientation of the headings therein.

In view of the foregoing amendments and remarks, applicants consider that the rejections of record have been obviated and respectfully solicit passage of the application to issue.

Please find attached a check for \$110.00 for a one month extension of time.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees to Deposit Account No. 11-0345. Please credit any excess fees to such deposit account.

Respectfully submitted,

KEIL & WEINKAUF

A handwritten signature in black ink, appearing to read 'HB Keil', written in a cursive style.

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AMENDMENTS WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION

Page 18, line 33 through page 21, line 14, substitute the Table II attached on separate pages. The orientation of the headings has been changed to portrait to conform to the remainder of the table.

IN THE CLAIMS

Please amend claims 2, 8 and 10 to read as follows:

2. (currently amended) Compounds of formula I ~~according to claim 1~~

in which

R¹ is a straight chained or branched C₁-C₆-alkyl, C₂-C₆-alkenyl or formyl.

R² ~~is hydrogen, C₁-C₁₀-alkyl, C₂-C₁₀-alkenyl, C₂-C₁₀-alkynyl, C₄-C₁₀-alkadienyl, C₄-C₁₀-haloalkyl, C₃-C₆-cycloalkyl, C₈-C₁₄-bicycloalkyl, phenyl, naphthyl, 5- or 6-membered heteroaryl or heterocyclic groups containing one to four nitrogen atoms or one to three nitrogen atoms and one sulfur or oxygen atom as ring members;~~

R³ ~~is phenyl, C₃-C₆-cycloalkyl or 5- or 6-membered heteroaryl containing~~

besides carbon atoms one to four nitrogen atoms or one to three nitrogen atoms and one sulfur or oxygen atom as ring members;

R⁴ is halogen, amino, C₁-C₁₀-alkoxy, C₁-C₁₀-haloalkoxy, C₁-C₁₀-alkylamino or di-C₁-C₁₀-alkylamino;

wherein the bent line indicates that the double bond may be located between the 3- and 9- position or the 4- and 9-position; and the zigzag line indicates that the groups connected may have the (E)-or (Z)-configuration;

R¹ to R₄ groups independently from one another may be unsubstituted or substituted by one to three groups R^a;

R^a halogen, nitro, cyano, hydroxy, C₁-C₆-alkyl, C₃-C₆-cycloalkyl, C₃-C₆-cycloalkenyl, C₁-C₆-haloalkyl, C₃-C₆-halocycloalkyl, C₁-C₆-alkoxy, C₁-C₆-haloalkoxy, tri-C₁-C₄-alkylsilyl, phenyl, halo- or dihalophenyl or pyridyl.

8. (currently amended) A fungicidal ~~composition~~ mixture having a first compound of formula I as defined in claim 1 wherein R¹ is at least 3-position, and a second compound of formula I where R¹ is at the 4-position .
10. (currently amended) A method for controlling harmful fungi, which comprises treating fungi or the materials, plants, the soil or the seed to be protected against fungi attack with ~~an effective amount of a compound of formula I as claimed in claim 1~~ a fungicidal composition as claimed in claim 9.